

## **REMARKS**

Claims 2 and 4-8 are amended, claims 1 and 3 are canceled, and claims 9-12 are added herein. Claims 2 and 4-12 remain pending in the captioned case. Further examination and reconsideration of the presently claimed application are respectfully requested.

### **Priority Claim**

A certified English translation of the priority foreign application is submitted herewith in a separate paper.

### **Section 103 Rejections**

Claims 1-4 and 6-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,465,395 to Bartram (hereinafter “Bartram”) in view of U.S. Patent No. 6,611,776 to Waters et al. (hereinafter “Waters”). Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Bartram and Waters in view of U.S. Patent No. 5,914,959 to Marchetto et al. (hereinafter “Marchetto”). Claims 1 and 3 are canceled rendering rejection thereto moot.

To establish a case of *prima facie* obviousness of a claimed invention, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, there must be a reasonable expectation of success. As stated in MPEP 2143.01, the fact that references can be hypothetically combined or modified is not sufficient to establish a *prima facie* case of obviousness. *See In re Mills*, 916 F.2d. 680 (Fed. Cir. 1990). Finally, the prior art references must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d. 981 (CCPA 1974); MPEP 2143.03 (emphasis added). Specifically, “all words in a claim must be considered when judging the patentability of that claim against the prior art.” *In re Wilson* 424 F.2d. 1382 (CCPA 1970). Using these standards, Applicants contend that the cited art fails to provide teaching or suggestion for all features of the currently pending claims, and furthermore, cannot

be combined to do so. Several distinctive features of the present invention are set forth in more detail below.

**The cited art cannot be combined to provide a first mobile unit comprising a data source for generating a serial data stream, a transmitter for generating electrical signals from the serial data stream, and a controller coupled between the data source and the transmitter for controlling the serial data stream by: (i) storing data from the serial data stream, (ii) converting a data rate or data package size of said data source into a desired value of data rate or data package size, and (iii) outputting the stored data to said transmitter in accordance with the desired value of data rate or data package size.**

Amended independent claim 2 recites, in part:

Device for broadband transmission of digital signals between at least one first unit and at least one second unit mobile along a predetermined path relative to said first unit, via non-contacting rotary joints, wherein said first unit comprises: a data source for generating a serial data stream; a transmitter for generating electrical signals from said serial data stream from said data source; a controller coupled between said data source and said transmitter for controlling said serial data stream by converting a data rate or data package size of said data source into a desired value of data rate or data package size, wherein said controller comprises: means for storing data from the serial data stream; and means for outputting the stored data to said transmitter in accordance with the desired value of data rate or data package size; and a transmitter conductor array for conducting said electrical signals generated by said transmitter...

Amended claim 8 recites a similar limitation. Support for the amendments made to claims 2 and 8 may be found on pages 3-7 of the originally filed specification. As such, the amendments made to the claims does not introduce new matter.

Bartram discloses a communication system that utilizes leaky feeder cables (Bartram, Abstract). The communication system disclosed by Bartram does not include a controller, which is coupled between a data source and a transmitter for controlling a serial data stream, as recited in claims 2 and 8. The Examiner agrees. For instance, statements in the Office Action admit that “Bartram does not expressly disclose ... that a controller is provided for controlling said data stream.” (Office Action, page 3).

However, further statements in the Office Action allege that Waters can be combined with Bartram to overcome the deficiencies therein. In particular, the Office Action alleges that Waters provides teaching for a controller that changes data rate in column 3, line 66 – column 4, line 13 of Waters. The Office Action concludes that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a controller to change data rate [as] taught by Waters et al. into the device of Bartram, in order to maintain or improve communication quality.” (Office Action, page 3). Applicants respectfully disagree and assert that the Bartram and Waters cannot be combined to provide teaching or suggestion for the controller recited in claims 2 and 8.

As shown in Figures 1-2, Waters provides a mobile device 1 including an antenna 2, a receiver 3, a processor 4, and a transmitter 5. As set forth in column 2, line 66 – column 3, line 57 of Waters, the antenna 2 and receiver 3 of the mobile device 1 receive signals from other mobile devices in a short-range network. A signal quality indicator 8 included within the receiver 3 of the mobile device 1 measures the strength of the signals received from the other mobile units. The signal strength measured by the mobile device 1 is broadcast to all of the other mobile devices in the network. The processor 4 of the mobile device 1 combines the signal strengths measured and received from the other mobile devices to provide an accurate measurement of signal strength for each mobile device in the network. The processor 4 compares the measured signal strength for a given device to a predetermined low level signal to determine if that device is about to leave the network.

In column 4, lines 8-13, Waters suggests that “[i]t would also be possible to use the measured signal strength ... to instruct the sender of the signals concerned to change the sending data rate, for example to increase the data rate where received signal strength has decreased, or a received signal has been subjected to increased distortion.” In other words, Waters suggests that a first mobile device receiving signals from a second mobile device could instruct the second mobile device (i.e., the “sender”) to change the sending data rate if the signal strength received by the first mobile device is low or subject to distortion.

The Examiner alleges that the passage cited above provides teaching for “a controller to change data rate,” and assumes that such a controller would obviously or inherently include means for storing data and outputting the stored data to the transmitter in accordance with the new data rate (see, e.g., Office Action, page 4 where it is stated “obviously there is temporary cache for processing data”). The Applicants disagree, for at least the reasons set forth below.

Although Waters suggests that “[i]t would also be possible to use the measured signal strength... to instruct the sender of the signals concerned to change the sending data rate,” Waters provides absolutely no indication that the data rate may be changed by a controller coupled, for example, between a data source and a transmitter of the mobile device sending signals across the short-range network (i.e., within the “sender”). There is even less indication within Waters for a controller, which includes means for storing data and outputting the stored data to a transmitter in accordance with the new data rate.

The Examiner assumes that such a “controller” is present within the mobile device of Waters, and supports such an assumption by citing column 4, lines 8-13 of Waters and stating “obviously there is temporary cache for processing data” (Office Action, page 4). However, if *assumptions* are considered, one might also assume that Waters changes the sending data rate by broadcasting a new data rate from a first mobile device (i.e., a “receiver”) to the data source or transmitter component of a second mobile device (i.e., the “sender”). Such an assumption would not necessarily include a “controller,” as presently claimed.

As set in MPEP 2112, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must

provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The extrinsic evidence provided by Waters does not make clear that the missing descriptive matter (i.e., a controller configured as set forth in claims 2 and 8) is necessarily present within the mobile device described by Waters. Furthermore, the assumptions provided in the Office Action do not reasonably support the determination that the allegedly inherent characteristic (i.e., a controller configured as set forth in claims 2 and 8) necessarily flows from the teachings of the applied prior art. Accordingly, Applicants assert that the Examiner has failed to support a *prima facie* case of obviousness and respectfully request that the §103(a) rejection of claims 2 and 4-8 be removed.

#### **Patentability of Added Claims**

Claims 9-12 are added in the present response. Support for the addition of claims 9-12 may be found, e.g., on pages 3-5 of the originally filed specification. As such, the addition of claims 9-12 does not introduce new matter. Claims 9-11 are dependent on claim 8, and are patentably distinct over the cited art for at least the same reasons as claim 8. Claim 12 is dependent on claim 1, and is patentably distinct over the cited art for at least the same reasons as claim 1. Accordingly, Applicants respectfully request that claims 9-12 be allowed.

#### **CONCLUSION**

The present amendment and response is believed to be a complete response to the issues raised in the Office Action mailed January 14, 2009. If the Examiner has any questions, comments or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Daffer McDaniel, LLP Deposit Account No. 50-3268.

Respectfully submitted,

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